Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS L. GUSTAFSON
and RICHARD MENTAL

Appeal No. 2003-0001
Application 09/360,573

ON BRIEF

Before WARREN, OWENS and MOORE, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the rejection of appealed claims 25 through 34, [1] all of the claims in the application, under 35 U.S.C. § 103(a) as being unpatentable over Gustafson et al. (Gustafson) '345 or '427[2] in view of either Meggs et al. (Meggs) or Gross.[3]

In order to establish a *prima facie* case of obviousness, the examiner must show that

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[1] See specification, pages 17-19.
[2] We refer to the Gustafson references collectively as Gustafson.
[3] Answer, pages 4-6. The rejection of the appealed claims under the judicially created doctrine of obviousness type double patenting has been withdrawn by the examiner (answer, page 4).

some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). The requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.

The parties agree that the differences between the claimed method encompassed by the appealed claims and Gustafson is that the method of the reference encapsulates an electroluminescent light (EL) strip instead of a light emitting diode (LED) light strip. The examiner relies on Meggs and Gross to support the position that one of ordinary skill in this art would have substituted the LED strip for the EL strip in order to take advantage of the different properties of the LED strip. As pointed out by appellants, "[a] main feature of Meggs is the presence of the internal void within the emergency light strip to form an internal surface. See col. 4, lines 36-40" (brief, page 7). We find that Meggs would have disclosed at col. 4, lines 22-43, in connection with Meggs **FIG. 2**, that the voids to which appellants refer have "prismatic surface **30** [which] comprises two planar facets forming side corner edges and a central apex point that extend the entire length of the housing member **4**," the reference further referring to other such embodiments in **FIGs. 4-7** (e.g., col. 5, lines 22-46). We further find that although Meggs discloses that "[t]he preferred embodiment . . . utilizes an extruded lightweight flexible transparent plastic resin for the housing member which is extruded to provide internal and exterior surfaces for reflection and refraction of the generated light" (col. 2, lines 16-20), the reference does not teach how such extrusion with the voids would be accomplished.

Appellants further submit that "Gross does not suggest a method of manufacture of the emergency light strip, nor does Gross suggest any method, other than the use of a U-shaped protective translucent plastic cover, to encapsulate the strips of light" (brief, page 6). Indeed, we find that Gross which would have disclosed an LED light strip covered with "a U-shaped protective translucent plastic cover **56**," for use in "confined areas," e.g., embedding the light strip in carpeting or other covering in a hall way, but does not disclose the method for making the LED strip or materials of which it is made (cols. 1-3 and **FIGs. 1-5**).

We must agree with appellants that, on this record, the disclosures of Gustafson, Meggs and Gross, separately or combined, would not have provided one of ordinary in the art with the motivation to encapsulate the LED strip of Meggs or Gross by the method of Gustafson. Thus, we conclude that the examiner has not pointed to some teaching, suggestion or motivation in the prior art to combine these references. *See Lee, supra; Smith Industries medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999); *In re Mayne*, 1043 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997); *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783; *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Keller*, 642 F.2d 413, 425-26, 208 USPQ 871, 881-82 (CCPA 1981). Indeed, the fact that a LED strip of Gross could be encapsulated by the method disclosed by Gustafson does not alone provide the basis for combining the applied prior art. *See, e.g., In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.").

Accordingly, the examiner has failed to establish a *prima facie* case of obviousness, and thus we reverse the ground of rejection.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN Administrative Patent Judge	)	
TERRY J. OWENS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JAMES T. MOORE Administrative Patent Judge	)	

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